

Application No.: 10/644,439

Docket No.: 60680-1801

**REMARKS**

The Office Action dated November 23, 2004 has been carefully reviewed and the foregoing remarks have been made in consequence thereof. Claims 1-10 are pending. No claims have been amended, cancelled, or withdrawn. No claims have been added.

In the Office Action Claims 1, 2, 5, 6, 9 and 10 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,937,684 to Long ("Long"). Claims 3, 4, 7 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Long in view of U.S. Patent No. 4,942,752 to Helfman ("Helfman").

**I. Claim Rejections Under 35 USC §102(b) in reliance upon Long**

Claims 1, 2, 5, 6, 9 and 10 were rejected under 35 U.S.C. §102(b) as being anticipated by Long. Applicant respectfully traverses the rejections. Applicant respectfully submits that a finding of anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. Claim 1, as amended, recites among other limitations, "a tool for grooving an outer surface of a valve guide, comprising. . . a tightening nut disposed about a portion of the tool body, and a means for rotating the at least one roller about the outer surface of the valve guide, and wherein the tool is capable of providing grooves on the outer surface of the valve guide." Long does not disclose a tool for grooving an outer surface of a valve guide, comprising . . . a tightening nut disposed about a portion of the tool body, a means for rotating the at least one roller about the outer surface of the valve guide, or the tool being capable of providing grooves on the outer surface of the valve guide. Rather, Long teaches a tool for forming the threading inside the hole of a circular cylindrical section having rotating cylinders. Specifically, Long discloses "a helicoidal threading inside a hole with smooth walls and of uniformly circularly section, this tap comprising a rigid body whose radial dimensions are smaller than those of the hole to be tapped...." (Col. 1, lines 50-53)

As stated above, claim 1 recites "a tightening nut disposed about a portion of the tool body...." The Examiner suggests that Long's annular ring 10 and end cover 11 comprise a tightening nut as recited by Applicant's claim 1. Applicant respectfully submits that annular ring 10 and end cover 11 do not comprise a tightening nut. Rather, annular ring 10 and end

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cover 11 are two separate components that merely hold rotating cylinders 4, 5, 6 in their respective receiving cavities 7. In particular, Long discloses that "the rotating cylinders 4, 5, 6 are removably held in their receiving cavities 7 by means of a lip 10 'of an annular ring 10 and a lip 11' of an end cover 11 which are fixed to the body 3 by respective screws 12, 13, 14" (Col. 2, lines 56-59 and FIG. 1). Thus, there is no disclosure or teaching of "*a tightening nut*" as recited by claim 1.

Furthermore, Long does not disclose a "*means for rotating the at least one roller about the outer surface of the valve guide.*" As stated in the foregoing, Long discloses a tool for making a threading *inside a hole* of a circular cylindrical section. Specifically, Long discloses that "the present invention relates to a tap for making, a deformation of matter, a helicoidal threading inside a hole with smooth walls and of uniformly circularly section, this tap comprising a rigid body whose radial dimensions are smaller than those of the hole to be tapped...." (Col. 1, lines 49-53) Thus, contrary to the Examiner's suggestion that free end 2 provide a means for rotating the rollers about a workpiece to provide grooves on an outer surface of the workpiece; the invention disclosed by Long is for making deformation of matter *inside a hole* as opposed to an *outer surface* of a valve guide.

Additionally, Long does not disclose a tool being capable of providing grooves on the outer surface of the valve guide, as recited in claim 1. Rather, as stated above, Long discloses a tap for making, by deformation of matter, a helicoidal threading inside a hole with smooth walls. (Col. 1, lines 50-53) Accordingly, the rejection of independent claim 1 should be withdrawn and the claim allowed for at least the above reasons. Claims 2-8, which depend from claim 1 are also allowable for at least the above reasons.

Moreover, claim 2 is patentable over the cited art on several independent bases. Claim 2 recites the tool body including a "longitudinally extending relief hole for allowing the tool to be disposed about the valve guide while a cylinder head is mounted to an engine." Long does not disclose a longitudinally extending relief hole for allowing the tool to be disposed about the valve guide while a cylinder head is mounted to an engine. The Examiner suggests, however, that Long's tubular space 19 is a relief hole. Applicant respectfully submits that tubular space 19 is not a hole at all, but merely a space that exists between the peripheral surface 18 and the

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outer periphery of the cylinders 4, 5, 6, as illustrated in FIG. 2. (also see Col. 3, lines 21-30) Accordingly, tubular space 19 is incapable of allowing the tab "to be disposed about the valve guide," as recited in claim 2. Applicant submits that claim 2, for at least the foregoing reasons is patentable over the cited art.

For at least the above reasons that claim 1 is patentable, independent claim 9 is also patentable over the cited art. Accordingly, each and every limitation of claim 9 is not disclosed or taught by Long. Claim 9 recites, among other limitations, "positioning the grooving tool about a valve guide, tightening a tightening nut disposed about a portion of a tool body of the grooving tool such that at least one roller of the grooving tool engage an outer surface of the valve guide, and loosening the tightening such that the at least one roller no longer engages the outer surface of the valve guide...." As stated in the foregoing, Long does not disclose positioning the tool about a valve guide. Rather Long discloses a tap for making, by deformation of matter, a helicoidal threading inside a hole with smooth walls. Furthermore, Long does not disclose tightening a tightening nut as recited in claim 9. Thirdly, Long does not disclose loosening the tightening nut such that the at least one roller no longer engages the outer surface of the valve guide. Accordingly, as required by 35 U.S.C. §102(b), Long does not teach or disclose each and every limitation of the claimed invention as recited by claim 9. Accordingly, the rejection of claim 9 should be withdrawn and the claims allowed for at least the above reasons.

**Claim Rejections Under 35 U.S.C. §103(a) in reliance upon Long in view of Helfman**

Claims 3, 4, 7 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Long in view of Helfman. Claims 3, 4, 7 and 8 depend from claim 1. For at least the foregoing reasons that claim 1 is patentable over the cited art, claims 3, 4, 7 and 8 are also patentable over the cited art. Applicant submits that the addition of Helfman does not cure the deficiencies of Long. Particularly, there is no motivation or teaching in either Long or Helfman, to combine the references and thereby render claims 3, 4, 7 and 8 obvious. As stated above, the invention in Long is directed to a tap for making helicoidal threading inside a hole with smooth walls. Helfman, on the other hand, is directed to reforming and restoring the *surface* of a workpiece. The references Long and Helfman have completely different purposes and applications. The

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addition of Helfman to Long would completely destroy the character and frustrate the objectives of Long. Accordingly, the Examiner has failed to provide the necessary suggestion or motivation to combine the cited references. Thus, Applicant respectfully requests withdrawal of the rejections.

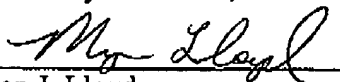
### CONCLUSION

In view of the above remarks, Applicant respectfully submits that the pending application is in condition for allowance. Favorable reconsideration and early allowance are earnestly solicited.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1801 from which the undersigned is authorized to draw.

Dated: January 24, 2005

Respectfully submitted,

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